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**OCT 24 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Scarantino, Nagle, and Kim : DECISION ON PETITION  
Application No. 10/089,483 :  
Filed: 17 September, 2002 :  
Atty Docket No. 9099-2IP :

This is a decision on the petition under 37 CFR 1.183 and 1.48(a)(1), filed on 7 October, 2005, which is being treated as (1) a petition under 37 CFR 1.48(a) to amend the inventive entity by the addition of Stefan Ufer, Jason Fiering, and Bahram Ghaffarazadeh Kermani; (2) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a)(2) which requires a statement from the person being added; and (3) a petition under 37 CFR 1.47(a), which requires an oath or declaration signed by all of the inventors.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision.

On 17 September, 2004, the application was filed with a declaration naming Charles W. Scarantino, H. Troy Nagle, and Chang-Soo Kim as joint inventors.

On 4 October, 2005, a non-final Office action was mailed, setting a three (3) month shortened statutory period for reply.

On 7 October, 2005, the present petitions under 37 CFR 1.47(a) and 1.48(a) were filed. Petitioners seek to add Ufer, Fiering, and Kermani as joint inventors. Petitioners further state that Ufer has refused to sign the statement of lack of deceptive intent required by 37 CFR 1.48(a) and the declaration required by 37 CFR 1.63 and 1.67. The petition is accompanied by consent of

the assignee(s), statements of lack of deceptive intent signed by Fiering and Kermani, and a declaration naming Scarantino, Nagle, Kim, Ufer, Fiering, and Kermani as the inventive entity, signed by all joint inventors except Ufer on behalf of themselves and inventor Ufer.

Petitioners further state, via the statement of registered patent attorney Elizabeth A. Stanek, that a copy of the declaration and the statement of lack of deceptive intent were sent to Ufer at his work address.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;

(2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43, or 1.47;

(3) the fee set forth in 37 CFR 1.17(i); and

(4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment

The petition of record does not comply with items (1) and (2). As petitioners also request consideration under 37 CFR 1.47(a), and the petition under 37 CFR 1.47(a) is not grantable for reasons discussed *infra*, the petition under 37 CFR 1.183 to waive 1.48 will be dismissed without prejudice to reconsideration pending submission of a grantable petition under 37 CFR 1.47(a).

#### **Petition Under 37 CFR 1.183 to waive 37 CFR 1.48**

37 CFR 1.183 provides that in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.<sup>1</sup>

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<sup>1</sup> MPEP 201.03(B).

Petitioners must show that the inability to obtain the statement from the inventor is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond their control. Under the circumstances of this case, petitioners should proceed as noted in more detail *infra* to make their showing in support of their request for waiver.

**Petition Under 37 CFR 1.47(a)**

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (5).

In regards to item (1), petitioners have not shown that Ufer was sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).<sup>1</sup> Based on the showing of record, it does not appear that the specification, including claims, and the drawings, were among the application papers sent to the non-signing inventor.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration and, in this case, the statement of lack of deceptive intent pursuant to 37 CFR 1.48(a)) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in

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<sup>1</sup> MPEP 409.03(d).

writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

With regards to item (5), it is noted a last known address for Ufer has not been specified. While the declaration and assignment were apparently sent to his work address, it appears that a residence address was included on the declaration filed with the petition. The last known address is that address at which the inventor customarily receives mail.<sup>2</sup> Ordinarily, the last known address will be the last known residence of the non-signing inventor.<sup>3</sup> Petitioners should specify, in their renewed petition, a last known address for the non-signing inventor. Additionally, the application papers and statement of lack of deceptive intent should be sent to the last known address of the inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (571) 273-8300  
                  Attn: Office of Petitions

By hand:          Customer Service Window  
                  Mail Stop Petition  
                  Randolph Building  
                  401 Dulany Street  
                  Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571.272.3231.



Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions

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<sup>2</sup> See MPEP 605.03.

<sup>3</sup> MPEP 409.03(e).